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| Applicant(s) | McCallister | <u>REPLY BRIEF</u> |
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| Examiner Name | Jean B Corrielus | |
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| Attorney Docket No. | 125.136USR1 | |
| Title: CONSTRAINED-ENVELOPE TRANSMITTER AND METHOD THEREFOR | | |

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. Awater and the fixed delay

On p. 10 of the Examiner's Answer, the Examiner cited US Patent No. 6,175,551 to support the proposition that a fixed delay is inherent in May. MPEP Section 2131.01(III) identifies the circumstances when it is proper to rely on a secondary reference to support an assertion of inherency in a rejection under 35 U.S.C. §102. Specifically, the MPEP states:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. **Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference**, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (The court went on to explain that "this modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges." 948 F.2d at 1268, 20 USPQ at 1749-50.). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed

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blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.). See also *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 139 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985).

(emphasis added). Appellant respectfully asserts that the Awater reference does not make clear that the "fixed" delay limitation is present in May. First, Awater does not explicitly state that its delay is fixed. Further, even assuming that the delay in Awater is fixed the Examiner has not explained why the system of May (which is different from Awater) would work with a fixed delay. Rather, the Examiner simply states:

In addition, for sake of argument, note US Patent No. 6,175,551 to Awater, see Fig. 6, for instance, that shows a fixed delay 66 (that can be used to implement the inherent delay used in May et al) used to delay a modulated signal while a correction signal is generated so that the modulated signal, i.e. output of the delay element, is provided in synchronism with a correction signal, i.e. output of device 84, to a summer 64.

This is not "evidence [that makes] clear that the missing descriptive matter is necessarily present in the thing described in the reference" as required by *Continental Can*. The Examiner has provided no evidence that a fixed delay would synchronize the modulated signal and correction signals in May. Furthermore, the Expert testimony of record in this appeal indicates that the delay, if any, in May must be variable. See, *Birch I*, paragraph 11. Even Mr. McCallister in his declarations filed in the counter part application (US Ser. No. 10/718,507) has not stated that May would work with a fixed delay. Therefore, Appellant respectfully asserts that Awater, and the other evidence of record, do not

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support the Examiner's position that a fixed delay is inherent in May. Reversal of the rejections is respectfully requested.

II. Combining May and Hedberg

On pp. 10-11, the Examiner addressed Appellant's argument that May and Hedberg should not be combined. Appellant notes that the Examiner here cites Awater in an attempt to justify the combination. However, the Examiner has again failed to provide the analysis required by *KSR*. Regarding the analysis required for an obviousness rejection, the courts have said:

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*). Appellant respectfully submits that the Examiner's statements regarding the combination of May and Hedberg, as justified by Awater, are mere conclusory statements and do not meet the requirements of 35 U.S.C. §103. Essentially, the Examiner argues that because both systems deal with peak to average power ratio, it would have been obvious to combine the references. There is no explanation or reasoning to explain the mental process that one of ordinary skill in the art would go through, using only ordinary creativity, to use these two references to create the claimed invention. Therefore, the rejection cannot be maintained.

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III. Conclusion

Based on the foregoing, and the arguments presented in the appeal brief, reversal of the rejections is respectfully requested.

Respectfully submitted,

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/David N. Fogg/

David N. Fogg
Reg. No. 35138

Attorneys for Appellant
Fogg & Powers LLC
5810 W. 78th Street, Suite 100
Minneapolis, MN 55439
T – (952) 465-0770
F – (952) 465-0771